

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The **identical invention must be shown** in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1 and 13 expressly require that the composition comprises "...a collagenase inhibitor at a concentration effective to reduce a collagenase activity in a skin, wherein the collagenase inhibitor comprises boron...". There is simply **no teaching** in the '425 reference that the '425 compounds have collagenase activity. In fact, the Examiner correctly recognizes that "...Miljkovic does not disclose the compositions as collagenase inhibitors..." (present office action page 3). Therefore, claims 1-8, 12-18, and 20 are not anticipated by Miljkovic.

35 USC § 103

Claims 1-12 and 13-20 were rejected under 35 USC § 103 as being obvious over Miljkovic (U.S. Pat. No. 6,080,425). In his rejection, the Examiner argues that while **Miljkovic fails to teach or suggest inhibition of collagenase**, the claimed compositions would be drawn to the reference's product *per se* which **inherently would inhibit collagenase activity**. The applicant agrees in some points and respectfully disagrees in others.

With respect to the lack of any teaching, suggestion or motivation in the '425 reference to use the reference compounds as collagenase inhibitors, the applicant agrees. On the contrary, the '425 reference employs preparations for "...skin rejuvenating...[to]...repair...damaged skin, [and to improve]...the look and feel of the skin..." (column 2, lines 43 et seq.). Such activity is a systemic activity, while collagenase inhibition is an activity on the molecular level, thereby teaching away from the claimed subject matter.

With respect to the inherency argument provided by the Examiner, the applicant disagrees. It is well established that the Examiner must provide rationale or evidence tending to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In *re Rijckaert*,

9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Nevertheless, in order to advance prosecution of the present application, the applicant provides a **terminal disclaimer** over the Miljkovic reference, which should moot the Examiner's obviousness argument.

ATTACHED MARKED-UP VERSION OF CHANGES

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

REQUEST FOR ALLOWANCE

Claims 1-20 are pending in this application. The applicant requests allowance of all pending claims.

Respectfully submitted,

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VERSIONS WITH MARKING TO SHOW CHANGES MADE

In the Claims

15. (Amended) The method of claim 13 wherein the cosmetic preparation [cosmetic] comprises a skin penetration [preparation] enhancer.

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